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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,152	02/27/2002	Tomio Endo	00184D/LH	3403

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,152	Applicant(s) ENDO ET AL.	
	Examiner Thong Q. Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 9 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/532,818.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>02272003</u> . | 6) <input checked="" type="checkbox"/> Other: <i>See Continuation Sheet</i> . |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 2/27/2003 and the Election of 10/20/2003.

Election/Restrictions

2. Applicant's election without traverse of Species (I) in the Election filed on 10/20/2003 is acknowledged. As a result of applicant's election, claims 8-12 directed to the elected species are examined in this Office action, and claims 13-14 directed to non-elected species (II) have been withdrawn from further consideration.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/532,818, filed on 3/21/2000. ***Drawings***

4. The drawings, which correct figures 5B, 6 and 9, were received on 02/27/2002. These drawings are approved by the Examiner.

Specification

5. The lengthy specification, which is amended by the amendment filed on 2/27/2002, has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

6. Claim 8 and 12 are objected to because of the following informalities. Appropriate correction is required.

- a) In claim 8: on lines 1-8, the claim recites the feature thereof "A confocal microscope comprising adapted to focus a beam of light...for observation, said microscope comprising". Such a recitation is unclear due to grammatical problems. Should the term "comprising" appeared on line 1 be deleted?
- b) In claim 12: on line 7, the claim refers to two terms such as "NTSC" and "PAL"; however, the claim fails to provide a definition for each term used in the claim. Further, the feature thereof "a distance trigger means or modifying the distance between said objective lens and said specimen" (lines 8-9) is unclear. Should the terms "or modifying" (line 8) be changed to – for modifying--?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 8 and 10, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Sumiya et al (U.S. Patent No. 5,638,206).

Sumiya et al discloses a confocal microscope having the following features: a) a system (400) for providing specimen to a stage of a microscope for observation wherein the stage (300) of the microscope is able to adjust in three directions for

the purpose of providing different area of the specimen for observation and for adjusting the focus; b) a microscope structure (500) having an illuminating system (30), a rotating disc (21) having a plurality of apertures, an objective lens system (41), and optics (75, 72, 51, 43, ...) wherein the light from the light source of the illuminating system is focused into the specimen (S) and the image of the specimen is guided to an image pickup system having a CCD (60); c) a control system (900, 600) connected to a monitor (700), a printer (800), the confocal microscope (500), the specimen transfer system (400), and the system for movement of the specimen (300). See columns 7-9, 14-15 and figs. 1-2. It is noted that the movement of the disc (21) and the frame of the image pickup system in a synchronization is disclosed as can be seen in column 9 and the movement of the specimen or the modification of the distance between the specimen and the objective lens of the microscope is disclosed in columns 14-15.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiya et al in view of Goldstein (U.S. Patent No. 4,827,125).

The confocal microscope having a rotary disc containing a mask pattern, an image pickup system, and a stage being movable for focusing as provided by Sumiya et al does not explicitly disclose that the objective lens of the microscope is able to move along the optical axis of the microscope for focusing. However, a focusing process in a microscope by either moving the stage supporting the specimen with respect to the objective lens of the microscope or moving the objective lens of the microscope with respect to the specimen is known to one skilled in the art as can be seen in the confocal microscope provided by Goldstein. See columns 8-9 and figs. 1-3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the confocal microscope provided by Sumiya et al by moving the objective lens with respect to the specimen as suggested by Goldstein for the purpose of focusing.

Allowable Subject Matter

11. Claims 9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is an examiner's statement of reasons for allowance:

The device as recited in each of claims 9/8 and 12/8 is patentable with respect to the cited art by the limitations relating to the structure of the drive means having a revolution detection means, an image pickup trigger means, and a distance trigger means wherein the operation of the distance trigger means is made in

synchronism with the rotational motion of the disc as detected by the revolution detecting means.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional reference is cited as of interest in which it discloses the movement of an objective lens on the basis of a signal outputted from a detecting system in a microscope.

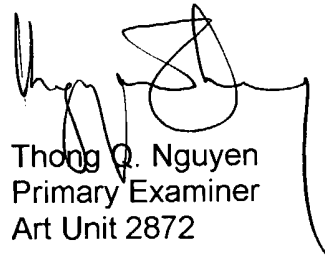
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. **Applicant is also advised that after January 20, 2004 the Examiner may be reached at his new telephonic number of 571-272-2316.** The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

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Thong Q. Nguyen
Primary Examiner
Art Unit 2872
